

SKI-SOU

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IN THE 1
Supreme Court of the United States

— o — o —
OCTOBER TERM, 1944

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No. 466

SKINNER MANUFACTURING COMPANY,
a Nebraska Corporation,

Petitioner,

vs.

GENERAL FOOD SALES COMPANY, Inc.,
a Delaware Corporation,

Respondent.

— o — o —
**PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE EIGHTH CIRCUIT AND BRIEF
IN SUPPORT THEREOF**

— o — o —
WILLIAM RITCHIE,
Omaha, Nebraska,
C. EARL HOVEY,
Kansas City, Missouri,
Counsel for Petitioner.

RITCHIE & SWENSON,
Omaha, Nebraska,
W. ROSS KING,
Omaha, Nebraska,
Of Counsel.



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a Nebraska Corporation,

Petitioner,

vs.

GENERAL FOOD SALES COMPANY, Inc.,
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Respondent.

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**PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE EIGHTH CIRCUIT AND BRIEF
IN SUPPORT THEREOF**
— o — o —

*To the Honorable Chief Justice and Associate Justices of
the Supreme Court of the United States:*

Your Petitioner, Skinner Manufacturing Company, a Nebraska corporation of Omaha, Nebraska, respectfully prays that a Writ of Certiorari issue to review a decision of the United States Circuit Court of Appeals for the Eighth Circuit, affirming a decree entered by the United States District Court, District of Nebraska, Omaha

Division, in the above-mentioned matter; and with respect thereto your Petitioner represents as follows:

I.

'Summary and Short Statement of the Matter Involved Nature of Case

This is a case in which the Petitioner charges the Respondent with infringement of Petitioner's trade-mark "Raisin-BRAN" as applied to a dry prepared breakfast food distributed by Petitioner.

Pleadings

In its prayer for relief, the Petitioner prays that, "the Court issue an order permanently enjoining and restraining the defendant from advertising, offering for sale, or selling, anywhere within the United States of America, any food product under the designation 'Raisin Bran', and from infringing and violating the plaintiff's right to the exclusive enjoyment and use of its trade mark 'Raisin-BRAN' in the distribution of any of plaintiff's food products." (T. 9). The Respondent alleged that the term "Raisin Bran" was so descriptive of Petitioner's product that the term could not be exclusively appropriated and that the term had not acquired a secondary meaning and Respondent denied any infringement of Petitioner's mark.

The Evidence

In June 1925, the Petitioner introduced on the American market for the first time a packaged dry prepared

1 In this Brief, A. with numbers following it indicate the Notes in the Appendix where reference to the Transcript will be found; F. stands for Finding or Findings of Fact; C. stands for Conclusion or Conclusions of Law; E. stands for Exhibit or Exhibits; T. stands for Transcript of Record.

breakfast food composed of cereal flakes similar to products popularly known as "bran flakes," and with which whole seedless raisins were mixed (T. 162-182). This product was never patented (T. 182).

The petitioner adopted and applied to this product the term "Raisin-BRAN," standing alone, and used and claimed this term as a trade-mark for its said product (T. 162-182). Prior to this, the term "Raisin-Bran," standing alone, had never been applied to any such product (A. 6), and had no commonly understood meaning (F. 8, T. 107; A. 12 k, l), and as the Trial Court found, "There is no such product or thing as the bran of a raisin. Nor is there any product or thing which may ordinarily and logically be characterized as a 'raisin bran' " (F. 8, T. 107).

The Petitioner registered the term "Raisin-BRAN" in the United States Patent Office under the Trade-Mark Act of March 19, 1920 (c. 104, 41 Stat. 533), (T. 109, 162; A. 8), and continuously thereafter placed its mark "Raisin-BRAN" at the top of the front label of each package of its product and under the mark carried the statement "Trade-Mark" and at the bottom of each label carried the statement "An exclusive product distributed by Skinner Manufacturing Company, Omaha, Nebraska" (E. 3, 4, 5, 6, 7, 8, 9, 10 and 21, Def's Ex. 31; T. 162, 163, 723, 727). The petitioner also used its mark as a trade-mark in its advertising (T. 210 to 241), and never intentionally used its own name in immediate connection with its mark and always discouraged others from doing so (F. 24, T. 114, 115), and Petitioner never used any other mark as a trade-mark for its product (E. 31a to z, 31a-1 to z-1, 31aa to yy, all inclusive) (T. 210-241).

For many years prior to 1942, the background of the label on the packages containing Petitioner's product had

been diagonal stripes of blue, white and yellow and the sides of the packages were blue (E. 3, 4, 5, 6, 7, 8, 9, 10). At all times, Petitioner on its packages, and frequently in its advertising, used a distinctive design of its trade-mark where the word "Raisin" was on one line, the word "BRAN" just below it, and the "R" of the "Raisin" was larger than other letters (E. 3 to 10, inclusive, 31a to z, 31a-1 to z-1, 31aa to yy, all inclusive—T. 210-241).

From June 1925 to April 1942, Petitioner had no competition for its product (T. 177, 497, 577) and had the exclusive use of its mark "Raisin-BRAN" as a designation for a breakfast food product (T. 177), and during that period expended many thousands of dollars advertising its product and its mark "Raisin-BRAN", had an extensive sales force representing it, and by April 1942 had established a large and profitable business in its said product in all parts of the United States (E. 11, T. 164; F. 16, T. 111; E. 24, T. 190-194; E. 14, T. 165-167; E. 15, T. 169-177, T. 504, 505).

In April 1942, the Respondent and Kellogg Company both introduced on the market products containing so-called "Bran Flakes" with which raisins were mixed. The Respondent designated its product "Post's Raisin Bran", and Kellogg Company designated its product "Kellogg's Raisin 40% Bran Flakes" (E. 3, T. 737; 52 F. S. p. 437).

The Respondent has for many years been a large distributor of breakfast food products, particularly "Bran Flakes"; in 1942, Respondent was the second largest distributor of breakfast food products in the United States

(T. 502), its products were in a major portion of the grocery stores of the United States, and it has spent millions of dollars advertising its products under its trade name "Post's" which was well known to most of the purchasing public (T. 495, 498).

Up to April 1942, the Respondent had packaged its so-called "Bran Flakes" in cartons which were brown and red or yellow and red (Ptf.'s E. 106-A to Q, incl., T. 715), and in the few years just preceding 1942, had carried the words "40% Bran Flakes" on the package. When Respondent prepared its label for the product to which it applied the designation "Post's Raisin Bran", Respondent changed the coloring to blue and white and emphasized on its package the words "Raisin Bran", so that that term was the most conspicuous feature of the label (A. 9; Df.'s E. 3, T. 737). Although the words "Raisin Bran" were in different style of letters from Petitioner's trade mark, the "R" was made larger than the rest of the letters and the word "Bran" was placed below the word "Raisin" so that there was a substantial similarity between Petitioner's trade mark "Raisin-BRAN" as it appeared on Petitioner's package and Respondent's designation.

With full knowledge of the Petitioner's business and the extent and particular distribution thereof (T. 493), the Respondent "engaged in an extensive and expensive sales and radio advertising campaign which included generally the area in which the plaintiff at that time had its most favorable and profitable distribution and did its most intensive advertising." 52 F. S. p. 437 (T. 516, 405-505; E. 15, T. 168-175). The Respondent made a special price, offering the package of its competing product so that it could retail in combination with Grape Nuts Flakes at two

cents per package (E. 51A, T. 517). As a result, the grocers advertised it for sale at prices ranging from nothing per package (in combination with Grape Nuts Flakes, to two cents, six cents and nine cents per package (A. 10).

Following the introduction of Respondent's product many retail grocers advertised it merely as "Raisin Bran" and others advertised it as "Post's Raisin Bran" or "Raisin Bran, "Post's",," but in many instances the word "Post's" was in much smaller print than the words "Raisin Bran" (A. 10; T. 522, 523, 524). Out of 37 grocer witnesses who testified that they waited on customers as opposed to self-service stores (A. 4a), 16 testified that after April 1942, on an order for "Raisin Bran" they delivered whichever was handiest or most profitable, etc. (T. 274, 297, 415, 538, 557, 600, 606, 610, 620, 639, 663, 666, 672, 675, 693, 694), although 28 of these witnesses testified that before the advent of the Post and Kellogg products their customers called for Petitioner's product under the designation "Raisin Bran" (A. 4f), and 16 of these witnesses testified that when their customers asked for just "Raisin Bran," it was Petitioner's product they desired (A. 4g).

The evidence disclosed 4 consumers who were definitely confused between Petitioner's and Respondent's packages, by Respondent's use of the term "Raisin Bran" (A. 3i); and two retail grocers testified that their customers had been confused (T. 294, 297). To offset this, the Respondent adduced evidence of consumer witnesses who said they were not confused (A. 11), and of others, both consumers, retailers and wholesalers, who, after looking at the two packages, generally placed side by side, said they would not be confused (A. 11), and of retailers

who testified they did not know of any of their customers who were confused (A. 13).

All of the testimony was taken after Kellogg and the Respondent had initiated their intensive radio and newspaper advertising campaigns which were well calculated to break down the understanding of the consuming public that the term "Raisin Bran" signified a single thing coming from a single source, and to lead consumers to understand that "Raisin Bran" meant the product of any one of the then three distributors.

The Petitioner introduced evidence which showed that it had received thousands of letters from users of its product which proved that they understood that the Petitioner was the source of origin of "Raisin-BRAN" (E. 43 and 54, T. 207 and 209, T. 195; F. 20, T. 113).

The oral testimony which bears upon the issue as to whether or not Petitioner's trade-mark "Raisin-BRAN" acquired a secondary meaning is not of a nature which could be truly called conflicting. It comes from 91 consumer witnesses, 5 of whom appeared before the Court in person (T. 331, 331, 509, 509, 580) and the rest of whose testimony was introduced by deposition; 58 retail grocers, all of whose testimony was offered by deposition; 35 wholesale grocers, 2 of whom appeared in person (T. 332, 507) and the rest of whose testimony was introduced by deposition; and 18 brokers and salesmen representing the Petitioner, 7 of whom appeared before the Court in person (T. 258, 263, 267, 270, 282, 334, 337), and the rest of whose testimony was introduced by deposition. The testimony of these witnesses relates to the understanding, knowledge and practices of such witnesses, but

does not present a conflict of evidence which destroys the credibility of any of them.

There were 86 consumer witnesses who had used "Raisin-BRAN" (A. 3a); there were 30 consumer witnesses who testified that the term "Raisin-BRAN" meant the Petitioner's product (A. 3i); and 34 consumer witnesses knew that "Raisin-BRAN" was a product of the Petitioner (A. 3c); 9 consumer witnesses testified that although they did not know the name of the distributor, they did know that prior to the advent of the Post and Kellogg products, there was only one breakfast food designated "Raisin-BRAN" on the market (A. 3d); 39 consumer witnesses identified the Petitioner's product as the only one they have been accustomed to purchase as "Raisin-BRAN", and of these, 30 knew the name of the distributor (A. 3e, 3f); 17 consumers testified that when they wished the Petitioner's product, they asked for "Raisin-BRAN" (A. 3g), and the Trial Court in its opinion said that prior to April 1942, when consumers asked for "Raisin-BRAN" they were supplied with the Petitioner's product (F. 15, T. 111).

There were 37 retailer witnesses who gave evidence that they did a service business and 15 of these witnesses testified that before the advent of the Post and Kellogg products, their customers called for the Petitioner's product under the designation "Raisin-BRAN" (A. 4f); 16 testified that when their customers asked for just "Raisin-BRAN" they desired the Petitioner's product (A. 4g); and 28 retail grocers testified that the term "Raisin-BRAN" meant the Petitioner's product (A. 4i).

Six of the Petitioner's sales representatives, with wide experience in the trade, and 31 wholesale grocers

with equally broad experience testified that prior to the advent of the Post and Kellogg products, the term "Raisin-BRAN" meant Petitioner's product both in the whole-sale and retail trade (A. 5c).

The Trial Court found that "at all times during the marketing of plaintiff's product, nearly all wholesale dealers in food products and a majority of retail dealers in such products knew that the plaintiff was the distributor of 'Raisin-BRAN' and the only distributor of a product containing like ingredients or having a similar name" (F. 12, T. 109).

A substantial amount of testimony was elicited from the consumer and retail grocer witnesses in answer to the question propounded by Respondent's counsel, "What *does* the term raisin bran mean to you?" (A. 12a). Most of the witnesses gave their understanding as of a time after General Foods and Kellogg products carrying the designations "Raisin Bran" were on the market and with such competitive products in mind (A. 12b); and many of these witnesses also testified that the term "Raisin Bran" meant the Petitioner's products, before the advent of the General Foods and Kellogg products (A. 12c); some of these witnesses answered in response to leading and suggestive questions (A. 12d); and others testified without any real knowledge on the subject (A. 12e), or were answering requests for dictionary definitions (A. 12f).

Only five witnesses, in answer to the question, "Does the term Raisin Bran mean any particular producer or manufacturer?" or words to that effect, answered "No" (A. 12g), and two of these witnesses understood that "Raisin Bran" meant the Petitioner's product before the advent of competition.

The testimony of all but a few of the witnesses who answered the questions, "What does Raisin Bran mean to you?" and "Does it mean any particular producer or manufacturer?" shows that the witnesses also understood the trade-mark significance of the term Raisin Bran (A. 12a).

As soon as Petitioner became aware of Respondent's infringement, Petitioner wrote the Respondent demanding that it cease and desist from using Petitioner's trade-mark "Raisin-BRAN" as the designation for Respondent's product and from using the mark in selling and distributing its product (T. 28). To this Respondent replied, "General Foods Corporation has no intention to comply with your demand * * * the expression 'Raisin Bran' is merely a descriptive term * * *" (T. 29). Shortly thereafter the Petitioner filed its complaint.

Trial Court's Conclusions, Findings, Opinion and Decree

The Trial Court made 43 Findings of Fact (T. 105-123) 25 Conclusions of Law (T. 122-128), wrote an opinion found at 52 Federal Supplement at pages 432-452, and dismissed Petitioner's complaint with prejudice (T. 128).

An examination of the Findings of Fact, Conclusions of Law and Opinion of the Trial Court shows that the Trial Court predicated its Findings of Fact that there was no secondary meaning established by the Petitioner, upon the Court's Conclusions of Law:

(1) That a term which is composed of two words each of which is descriptive of an important constituent of a product cannot acquire a secondary meaning (52 F. S., pp. 445-448); (2) that the use of the word "bran" in

Respondent's trade-mark precluded the mark "Raisin-BRAN" from acquiring a secondary meaning (52 F. S. 448); (3) that a secondary meaning cannot be acquired by a term applied to an unpatented product during the time when the product to which the term is applied has no competition in the market (52 F. S. 448-449); (4) that the registration of the term "Raisin-BRAN" under the Trade Mark Act of March 1920, was void (C. 11, T. 126); (5) that the term "Raisin-BRAN" did not acquire a secondary meaning because a substantial portion of the consuming public did not know the personal identity of the distributor, even though many of them knew that it was a single thing coming from a single source and some of them actually knew the source of origin; the Court having concluded that the case of *Kellogg Company v. National Biscuit Company*, 305 U. S. 111, governed this case (52 F. S. 449), and that the case of *Coca Cola Co. v. Koke Co.*, 254 U. S. 143, did not (52 F. S. 449-450); (6) that proof of the following character is not sufficient to establish a secondary meaning;—" (a) An exclusive and long continued use of its designation during a period when no competition was in the field; (b) a wide distribution of its product; (c) a wide advertising campaign and large expenditures for advertising the product under the designation; and (d) identification of the product by its designation on the part of a substantial portion of the purchasing public; understanding by a substantial portion of the purchasing public and most of the retail and wholesale trade that the name signifies a single thing coming from a single source and covers a product made and distributed exclusively by the person who claims the brand; a recognition in the product of superior qualities or of excellence by a substantial portion of the purchasing public" (52 F. S. 448); (7) that evidence of those who

never heard of the product or who did not know its source of origin or for whom the term had acquired a dual significance, one characterizing the product, the other its source of origin, or who had been led by the advertising of the Respondent and Kellogg to understand the term applied to any product, negated positive, credible, uncontradicted evidence of many consumers, and retail and wholesale dealers who testified that the term meant the Petitioner's product, or a particular product coming from a single source; (8) that testimony of sales representatives of the Petitioner, with wide experience dealing with the trade, to the effect that in the mind of the consuming public the term "Raisin-BRAN" meant the Petitioner's particular product, and similar testimony of wholesale and retail grocers with wide experience in the trade, was incompetent as proof of a secondary meaning; (9) that there was no likelihood of confusion or palming off, even though there was positive evidence of both; (10) that there was no likelihood of confusion in the future because the Respondent and Kellogg engaged in an immediate extensive and intensive newspaper and radio advertising campaign and thereby caused many members of the consuming public to understand that the term applied to any product similar to Petitioner's (52 F. S. 437); (11) that the likelihood of confusion and palming off was to be determined by the reaction of an "ordinary cautious member of the public, using reasonable care and attention in purchasing," and by the Trial Court's "long and careful scrutiny" of the packages containing Petitioner's and Respondent's product (52 F. S. 450), and that such evidence outweighed the positive testimony of credible witnesses who were confused or who had palmed off the Respondent's product for that of the Petitioner; (12) that the use of Respondent's name

on Respondent's package and the use of different colored packages was sufficient to avoid a charge of unfair competition through the appropriation of Petitioner's trade-mark (52 F. S. 451).

Grounds for Appeal to Circuit Court of Appeals

The Petitioner appealed from this decree and urged as grounds for reversal that, (1) the Trial Court's Findings of Fact which were adverse to the Petitioner are mixed conclusions of law and fact and were predicated upon an erroneous view of the law; (2) the term "Raisin-BRAN," standing alone, as applied to Petitioner's breakfast food product was capable of acquiring a secondary meaning, and the Trial Court erred when it concluded and held otherwise; (3) Petitioner's registration of the term "Raisin-BRAN" under the 1920 Trade Mark Act was valid, and the Trial Court erred when it concluded and held otherwise; (4) as used by the Petitioner, the term "Raisin-BRAN" acquired a secondary meaning prior to the time that Respondent introduced its competing product, and the Trial Court erred when it concluded and held otherwise; (5) the Respondent was guilty of unfair competition in appropriating Petitioner's trade-mark "Raisin-BRAN," and the Trial Court erred when it concluded and held otherwise; (6) the Petitioner is entitled to the relief prayed for, and the Trial Court erred in finding, concluding and decreeing otherwise.

Decision of United States Circuit Court of Appeals, Eighth Circuit

The United States Circuit Court of Appeals for the Eighth Circuit, in an opinion found at Transcript Vol. VI, pp. 3-11, affirmed the decision of the Lower Court,

predicating its affirmance chiefly upon an approval of the Trial Court's Opinion and the conclusion that under Federal Rule of Practice No. 52, the Findings of the Trial Court that no secondary meaning had been established, that there was no confusion or palming off and no likelihood of confusion or palming off, were binding upon the Appellate Court.

In its opinion the Eighth Circuit Court of Appeals in effect held that the third sentence of Federal Rule of Civil Procedure No. 52 precluded the Appellate Court from reviewing the facts in an equity appeal. The Court also, among other things, held that the question "whether the similarities which exist between the packages used by the appellees and the packages used by appellant have caused or are likely to cause deception and confusion in the trade, is, we think, a question of fact for the Trial Court to determine. *Cleo Syrup Corporation v. Coca Cola Company*, 8th C. C. A., 139 F. 2d 417-418" (T. VI-10).

Petition for Writ of Certiorari

It is from the foregoing decision of the Eighth Circuit Court of Appeals that this Petition for Writ of Certiorari is taken.

II.

Basis Upon Which It Is Contended the United States Supreme Court Has Jurisdiction to Review

This Writ is sought under authority of Section 240 (a) of the Judicial Code (c. 231, Sec. 240 (a), 36 Stat. 1157) as amended February 13, 1925 (c. 229, Sec. 1, 43 Stat. 938; T. 28, Sec. 347 U. S. C.) (A. 14). The jurisdiction of the District Court and United States Circuit Court of Appeals are predicated upon Section 17 of

the 1905 Trade-Mark Act (A. 20) and Section 6 of the 1920 Trade-Mark Act (A. 21). There is a diversity of citizenship between the parties and the amount in controversy, exclusive of interest and costs, exceeds \$3,000.00 (T. 105, F. 1).

The decision of the United States Circuit Court of Appeals from which this writ is sought was handed down August 4, 1944 (T. Vol. VI, p. 3). This Petition for Writ of Certiorari is presented on September 15, 1944.

The opinion of the Eighth Circuit Court of Appeals on account of which this writ of Certiorari is sought is found at pages 3 to 11 of Volume VI of the Transcript of Record in this case. The opinion of the United States District Court, District of Nebraska, in this case is found at 52 Federal Supplement, pages 432 to 452, inclusive.

III.

Questions Presented

1. The Circuit Court of Appeals for the Eighth Circuit erred when it concluded that Federal Rule of Civil Procedure No. 52 precludes a review of the findings of the Trial Court on an appeal of an equity case (T. Vol. VI, pp. 8-9, 10).

2. The Circuit Court of Appeals for the Eighth Circuit erred when it found that the term "Raisin Bran" was the "primary generic meaning" of Petitioner's breakfast food product (T. Vol. VI, p. 8).

3. The Circuit Court of Appeals erred when it sustained the conclusion of the Trial Court that the case of *Kellogg Company v. National Biscuit Company*, 305 U. S.

111, governed a decision in this case and that the case of *Coca Cola Company v. Koke Company*, 254 U. S. 143, did not (T. Vol. VI, p. 8).

4. The Circuit Court of Appeals for the Eighth Circuit erred when it concluded and held that the term "Raisin-BRAN" could not acquire a secondary meaning for the reason that it was composed of two words which were descriptive of the two principal ingredients of the product to which it was applied (T. Vol. VI, pp. 7-9).

5. The Circuit Court of Appeals for the Eighth Circuit erred when it approved the Trial Court's Opinion, in which it was concluded that a trade-mark or trade term could not acquire a secondary meaning during the time the product to which it was applied had no competition in the market (T. Vol. VI, pp. 8-9).

6. The Circuit Court of Appeals for the Eighth Circuit erred when it approved the Trial Court's Opinion in which it was concluded that the following proof would not be sufficient to establish a secondary meaning: "(a) An exclusive and long continued use of its designation during a period when no competitor was in the field; (b) a wide distribution of its product; (c) a wide advertising campaign and large expenditures for advertising the product under the designation; and (d) identification of the product by its designation on the part of a substantial portion of the purchasing public; (e) understanding by a substantial portion of the purchasing public and most of the retail and wholesale trade that the name signifies a single thing coming from a single source and covers a product made and distributed exclusively by the person who claims the brand; (f) a recognition in the product of superior quality or excellence by a substantial portion

of the purchasing public" (52 F. S. 448) (T. Vol. VI, p. 8).

7. The Circuit Court of Appeals for the Eighth Circuit erred when it approved the Trial Court's Opinion in which it was concluded that the testimony of sales representatives of the Petitioner, with wide experience dealing with the trade, to the effect that in the mind of the consuming public the term "Raisin-BRAN" meant the Petitioner's particular product, and similar testimony of wholesale and retail grocers with wide experience in the trade, was incompetent as proof of a secondary meaning.

8. The Circuit Court of Appeals for the Eighth Circuit erred when it held that the term "Raisin-BRAN" had not acquired a secondary meaning and that it was bound by the Trial Court's finding to that effect (T. Vol. VI, p. 9).

9. The Circuit Court of Appeals for the Eighth Circuit erred when it concluded that the Respondent had the right to designate its product "Raisin Bran."

10. The Trial Court erred when it found that the Respondent, by placing its own name "Post's" on its package and packaging its product in a package with blue background had done all that was necessary to distinguish its product from that of Petitioner; and the Eighth Circuit Court of Appeals erred when it concluded that such findings were binding upon the Appellate Court (T. Vol. VI, p. 10).

11. The Trial Court erred in its finding that the proof did not show confusion and palming off of Respondent's product for the product of the Petitioner; and

the Eighth Circuit Court of Appeals erred in concluding that such findings of the Trial Court were binding upon the Appellate Court.

12. The Trial Court erred when it found that there was no likelihood of confusion and palming off; and the Eighth Circuit Court of Appeals erred when it concluded that such findings were binding upon the Appellate Court.

13. The Trial Court erred when it concluded that the equities in the case were in favor of the Respondent and against the Petitioner; and the Eighth Circuit Court of Appeals erred when it affirmed such a conclusion.

14. The Trial Court erred when it failed to grant the Petitioner the relief prayed for; and the Eighth Circuit Court of Appeals erred when it affirmed the opinion and decision of the Trial Court.

IV.

Reasons Relied Upon for Allowance of Writ

The questions involved in this proceedings are of substantial national importance, to wit:

(1) An interpretation is sought of that sentence of Federal Rule of Civil Procedure 52, which reads "Findings of fact shall not be set aside unless clearly erroneous" (A. 15). There is a conflict between the decisions of the Eighth Circuit Court of Appeals with respect to a proper interpretation of that sentence as shown by the opinion in this case (T. Vol. VI, pp. 8-9, 10) and the opinion in *Cleo Syrup Corporation v. Coca Cola Company*, 8th C. C. A., 139 F. 2d 416, and the following decisions

in other Circuits: *Eastern Wine Corporation v. Winslow-Warren, Ltd., Inc.*, 2nd C. C. A., 137 F. 2d 955; *Pfeifer Oil Transportation Co., Inc., v. The Ira S. Bushey, et al*, 2nd C. C. A., 129 F. 2d 607; *Kuhn v. Princess Lida of Thurn & Taxis*, 3rd C. C. A., 119 F. 2d 704; *Texas Agricultural Assn. of Edinburg, et al v. Hidalgo Co. Water Control Improvement District et al*, 5th C. C. A., 125 F. 2d 829; *Jarvis, Postmaster, v. Shackleton Inhaler Co.*, 6th C. C. A., 136 F. 2d 116; *Equitable Life Assurance Society of the United States v. Irelan*, 9th C. C. A., 123 F. 2d 462; and this Court has never rendered any final decision in the matter.

(2) A determination is sought as to whether or not a trade name which is composed of words descriptive of one or more of the ingredients, or of the qualities or uses, of an unpatented product, and which product may be aptly designated by another term, may acquire a secondary meaning against the use of said term by a competitor. There is a conflict between the decisions of the Eighth Circuit Court of Appeals in this case on this question, and the decisions of the Second, Third and Sixth Circuits in the following cases: "Spunlo," *Industrial Rayon Corporation v. Dutchess Underwear Corporation*, 2nd C. C. A., 92 F. 2d 33; "Dyanshine," *Barton v. Rex Oil Co.*, 3rd C. C. A., 29 F. 2d 474; "Coca-Cola," *Nashville Syrup Co. v. Coca-Cola Co.*, 6th C. C. A., 215 F. 527; "Hot-Patch," *Shaler Co. v. Rite-Way Products, Inc.*, 107 F. 2d 82.

(3) A determination is sought as to whether or not a secondary meaning may be acquired for a trade name or trade-mark applied to an unpatented product during a period when there is no competition in the market with

such product. There are conflicting decisions with respect to this question between the Eighth Circuit Court of Appeals and the Sixth Circuit Court of Appeals. In its opinion in this case, the Eighth Circuit Court of Appeals approved the opinion of the District Court, in which opinion the Trial Court quoted with approval from *Kellogg Toasted Corn Flake Company v. Quaker Oats Company*, 6th C. C. A., 235 F. 657, 665, 666, to the effect that secondary meaning may not be established in a trade-mark or trade name during a period when no one else was either making or dealing in the article to which the mark was applied; whereas in the case of *Saalfield Publishing Co. v. G. & C. Merriam Co.*, 238 F. 1, in Note 3 at the bottom of page 9, the Sixth Circuit Court of Appeals says: "Where an article is put out under a trade name which, although it may be called descriptive, is yet also something more than merely descriptive, and where the public is free to compete in the same article and in the same name, but for a long period refrains from both, this seems to the writer the ideal soil in which the secondary meaning may grow into effective existence. The name points to one maker only without confusion or uncertainty and it is a sure 'badge of origin'"; this Court has never rendered a decision on this question.

(4) There appears to be a conflict of decisions between the following statements made in opinions of this Court, to wit:

"The name now characterizes a beverage to be had at almost any soda fountain. It means a single thing coming from a single source and well known to the community. It hardly would be too much to say that the drink characterizes the name as much as the name the drink. In other words, Coca Cola probably means to most persons the plaintiff's familiar

product, to be had everywhere, rather than a compound of particular substances. * * * We see no reason to doubt that, as we have said, it has acquired a secondary meaning in which, perhaps, the product is more emphasized than the producer but to which the producer is entitled."

Coca Cola Co. v. Koke Co., 254 U. S. 143, 146.

"But to establish a trade name in the term 'Shredded Wheat' the plaintiff must show more than a subordinate meaning which applies to it. It must show that the primary significance of the term in the minds of the consuming public is not the product but the producer."

Kellogg Company v. National Biscuit Co., 305 U. S. 111, 118.

The opinion in the latter case does not sufficiently distinguish the difference in facts between the Coca Cola case and the Shredded Wheat case to make clear the distinctions between the rules laid down in the two cases, and when one rule should apply or when the other, and such distinction has never been clearly pointed out by this Court.

(5) A determination is sought as to what character of proof will establish a secondary meaning in a trade name or trade-mark. There is a conflict between the decision of the Eighth Circuit Court of Appeals in this case on this question and the decisions of the Third, Fourth and Sixth Circuits in the following cases: *Barton v. Rex Oil Co.*, 3rd C. C. A., 29 F. 2d 474 (2 F. 2d 402); *Coca Cola v. Old Dominion Beverage Corporation*, 4th

C. C. A., 271 F. 601; *Little Tavern Shops v. Davis*, 4th C. C. A., 116 F. 2d 903, 906; *Grocers Baking Co. v. Sigler*, 6th C. C. A., 132 F. 2d 498.

(6) The issues of fact and law in this case which are raised by the evidence, pleadings and opinions of the Lower Courts, are so comprehensive that they will permit of a decision which will clarify the law of unfair competition as it relates to trade-marks and trade names composed of surnames, geographic names or terms containing words descriptive of the contents or uses of the products to which such terms are applied.

(7) There are many decisions relating to the law of unfair competition as it relates to trade-marks and trade names composed of surnames, geographic names or terms containing words descriptive of the contents or uses of the products to which such terms are applied; on cursory examination, many of these decisions seem to be conflicting, and there is no decision which has clearly pointed out the distinctions by which these numerous decisions may be reconciled and their applicability to any particular set of circumstances determined. The issues of fact and law in this case which are raised by the pleadings, evidence and opinions of the Lower Courts are so comprehensive that they will permit a decision which will reconcile the numerous decisions on the questions raised, and make clear their applicability to any particular set of circumstances.

(8) The determination of this case will affect a

substantial portion of the grocery trade and purchasing public in all parts of the United States.

Respectfully submitted,

WILLIAM RITCHIE,
Omaha, Nebraska,

C. EARL HOVEY,
Kansas City, Missouri,
Counsel for Petitioner.

Of Counsel:

RITCHIE & SWENSON,
Omaha, Nebraska,

W. ROSS KING,
Omaha, Nebraska.